

REMARKS

INTRODUCTION

The Office Action dated May 28, 2003, and the references cited therein have been carefully considered. In response, the applicant offers the following remarks.

OFFICE ACTION REJECTIONS

Claim 10 is rejected under 35 U.S.C. Sec. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Claim 1-8, 10-14 and 16-24 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable in view of U.S. Patent No. 6,146,273 ("Olsen").

Claims 9 and 15 are rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over U.S. Patent No. 6,146,273 ("Olsen") in view of U.S. Patent No. 6,159,095 ("Frohm et al.").

SYNOPSIS OF PRIOR ART

U.S. Patent No. 6,146,273, inventor Olsen: A gaming machine that displays a plurality of segments apparently is disclosed. Each time the computer receives a signal, a new segment on a random basis is turned over to reveal a portion of a picture. If an eligible player is able to discern what the entire picture is, then the player is entitled to yet another prize.

U.S. Patent No. 6,159,095, inventor Frohm et al: A game wherein apparently a plurality of squares are displayed and upon the calling of a specific number, the display is changed from displaying the keno square to the highlighted version indicating a specific keno number.

ARGUMENTS FOR PATENTABILITY

All the pending independent claims call for a plurality of first displayed items, such as playing cards (claims 1, 18 and 21), keno number spaces (claim 7) or a bingo card number spaces (claim 13), to change to displaying a display object inside the first displayed items wherein the portions of the display object create an identifiable object. The Office Action states that the independent claims are obvious under section 103 in view of the Olsen reference.

Under relevant case law and according to MPEP section 2143.01, a suggestion or motivation is needed to modify a reference and there are three possible sources for a motivation: the nature of the problem to be solved; the teachings of the prior art; and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). MPEP 2143.01 explains more specifically when it is and is not proper to find motivation to modify a reference under 35 U.S.C. Sec. 103.

The proposed modification to the Olsen reference would make it unsatisfactory for its intended purpose, which, according to MPEP 2143.01, means there is no motivation to modify the reference. The relevant part of the Olsen reference apparently describes how a picture is purposely obscured by segments and these segments are randomly turned over to allow the player to attempt to discern the picture. As a result, bits and pieces of the picture are displayed, making it a challenge for the player to guess what the identity of the entire picture. In short, the cited section of the Olsen reference basically describes a guessing game.

The pending independent claims call for the first display items (cards in claims 1, 18 and 21, keno squares in claim 7, bingo squares in claim 13) to be overturned "wherein the portions of the display object create an identifiable image." In order to modify Olsen to match the pending claims, Olsen would have to turn over segments to create an identifiable image. By modifying Olsen to include turning over segments to create an identifiable image,

the purpose of Olsen of creating a mystery which the player can attempt to guess would be eliminated.

As called for in the pending independent claims, the image must become identifiable. There is no guessing as to the identity of the displayed image in the pending independent claims as the image is identifiable. The game aspect of the Olsen reference would be lost because all the segments would be turned over and the image would become identifiable. Olsen would no longer be fit for its intended purpose of being a guessing game because the modified Olsen would no longer be a guessing game but merely a short wait until all the segments are overturned and the picture is identifiable as called for in the pending independent claims. Therefore, according to MPEP 2143.01, there is no motivation to modify the Olsen reference because the Olsen reference would no longer be fit for its intended purpose of being a guessing game.

In addition, the proposed modification of the Olsen reference would change the principle of operation of the device disclosed in the Olsen reference, which according to MPEP 2143.01, means that there is no motivation to make the proposed modification to the Olsen reference. The Olsen reference attempts to create a game by allowing a player to guess at the identification of a picture while the picture is obscured by segments which are randomly overturned. In other words, the principle of the Olsen reference is to make a player guess to determine a picture obscured by segments.

In order to modify Olsen to match the pending claims, Olsen would have to turn over segments to create an identifiable image. If the image is identifiable as called for in the pending claims, no guessing would be necessary. The principle of operation in Olsen, a guessing game, would be lost because the player would no longer have to guess at the identification of the picture because it would be identifiable. According to MPEP 2143.01, as the proposed modification to the Olsen reference would change the principle of operation of

the Olsen reference by changing it from a guessing game to a non-guessing game, there is no motivation to modify the Olsen reference.


CONCLUSION

In conclusion, the applicant respectfully submits that the modified Olsen reference would no longer be a guessing game in contrast to its intended purpose and principle of operation. As a result there is no motivation to modify the Olsen reference. The applicant submits that all pending claims are novel and non-obvious and are in condition for allowance. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, she is respectfully invited to telephone the undersigned.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300

By:



William J. Kramer
Registration No. 46,229
Attorney for Applicant

September 8, 2003